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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,778	06/07/2001	Jan L. Clatty	Mo6418/MD-01-49-PU	8857

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02/06/2006

Patent Department
Bayer Corporation
100 Bayer Road
Pittsburgh, PA 15205-9741

EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/876,778

Applicant(s)

CLATTY, JAN L.

Examiner

John m. Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's arguments filed 11-3-05 have been fully considered but they are not persuasive.

The following rejections are maintained:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurth (6,180,686).

Kurth discloses isocyanate-reactive compositions comprising blown soy oil, crosslinking agent, blowing agent, and catalysts in amounts encompassing of appellant's claims (see the entire document).

Kurth differs from appellant's claims in that it is directed to the avoidance of environmentally questionable and relatively expensive petrochemical based polyols. However, its disclosure is replete with recognition of the well known nature of the polyols being avoided including specifics of molecular weight and functionality preferences for the various conventional polyols which they discuss to be well studied (see column 1 line 67 – column 2 line 29) which well encompass the molecular weight and functionality values claimed by appellant. Accordingly, it would have been obvious for one having ordinary skill in the art to have utilized petrochemical based polyether

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based polyols disclosed/avoided by Kurth in accompaniment with blown soy oil for the purpose of imparting relative non-degradability to the products being produced therefrom in order to arrive at the products of applicant's claims with the expectation of success in the absence of a showing of new or unexpected results. All disclosures of the prior art, including unpreferred or auxiliary embodiments, must be considered in determining obviousness. *In re Mills*, 176 USPQ; *In re Lambedi*, 192 USPQ 278', *In re Boe*, 148 USPQ 507.

On appeal examiner set forth the following arguments which were considered by the Board of Appeals in affirming examiner's rejection. They are maintained to be still applicable:

Appellant's arguments have been considered but rejection is maintained as the reference's disclosure taken in its completeness is seen to fairly suggest appellant's (applicant's) claimed invention as characterized by examiner. No additional reference is seen to be necessary to support examiner's position of obviousness because the reference is specific as to the materials being avoided. If one were not interested in obtaining the full ecological advantages associated with their preferred isocyanate reactive component, then they would have been *prima facie* motivated to use the recited other well-known conventional petrochemical isocyanate-reactive materials identified by Kurth for their property engineering effects described.

Applicant's showing has been considered. However, showings of new or unexpected results which are commensurate in scope with the scope of the instant claims are not demonstrated in the affidavit evidence presented sufficient to overcome the instant rejection.

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Applicants' most recent arguments have been considered, but rejection is maintained for all of the reasons set forth above. Applicants' showings of results are maintained to fail to set forth the sufficient showing of new or unexpected results, which are commensurate in scope with the scope of the claims, required to overcome the instantly set forth rejection. Applicants' affidavit evidence, while covering the range of amount values for component a.) of their claims, is directed toward selections from only one member of their claimed component a.), one specific combination of polyols from their claimed component b.), and no selectivity among the chain extender/crosslinkers, blowing agents, and catalysts of their claims. Comparison commensurate in scope with the scope of the claims is required in order to overcome examiner's prima facie case of obviousness.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,649,667. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims disclose isocyanate reactive compositions which are further employed in preparations of finished products, and the instant claims fully encompass the invention claimed in U.S. Patent No. 6,649,667.

Applicants' arguments have been considered, and rejection is maintained for the reasons set forth above. The claims rejected above are of a different scope than the claims restricted in the parent, and the restriction in the parent case does not preclude rejection of the claims in the instant case.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700